

REMARKS

Rejections

Rejections under 35 U.S.C. § 102(e)

Claims 132-136 and 138-144

Claims 132-144 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Munyan, U.S. Patent No. 5,761,485. Applicant notes that the Examiner actually rejected claim 137 over the combination of Munyan and Ferrel et al., U.S. Patent No. 6,230,173, and therefore the rejection of claim 137 will be treated as a rejection under 35 U.S.C. § 103. Applicant does not admit that Munyan is prior art and reserves the right to swear behind Munyan at a later date. Nonetheless, Applicant respectfully submits that Applicant's invention as claimed in claims 132-136 and 138-144 is not anticipated by Munyan.

Munyan discloses an electronic book device that communicates with a electronic bookstore server to download content. The electronic book device includes a slot for a removable storage device that holds the downloaded content and a security circuit containing a security identification code that uniquely identifies the particular electronic book. The security circuit codes each removable storage device with the security identification code for the particular electronic book device so that the removable storage device cannot be accessed by a different electronic book device.

In contrast, in claims 132-136 and 138-144, Applicant claims a system that includes targeting logic for generating a targeted header based on information indicative of a player ID. The targeted header is subsequently downloaded with the associated content to a player. It appears that the Examiner is equating Applicant's targeting logic with Munyan's security circuit and Applicant's targeted header with Munyan's security coding of the removable storage device. However, in Applicant's claimed invention, the targeting logic is external to the player while Munyan's security circuit is within the electronic book device. Furthermore, Applicant's claimed targeted header is associated with content, while Munyan's security coding is associated with the removable storage device as a whole, not with the individual content files. Finally, Applicant claims downloading the targeted header and the associated content to a player, while Munyan

does not teach or suggest that the electronic bookstore server downloads a targeted header with the content to the electronic book device. Therefore, Munyan cannot be properly interpreted as disclosing Applicant's invention as claimed in claims 132-136 and 138-144.

Accordingly, Applicant respectfully submits that the invention claimed in claims 132-136 and 138-144 is not anticipated by Munyan under 35 U.S.C. § 102(e) and respectfully requests the withdrawal of the rejection of the claims.

Rejections under 35 U.S.C. § 103

Claims 39-53 and 55-131

Claims 39-53 and 55-131 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ferrel et al., U.S. Patent No. 6,230,173, in view of Munyan. Because claim 137 was rejected over a combination of Munyan and Ferrel, Applicant is presenting arguments for the patentability of claim 137 under § 103. In addition, Applicant notes that claims 56-68 and 106 were not individually rejected. Applicant assumes the Examiner would have rejected claims 56-68 based on a rationale similar to that used to reject claim 72. Claim 106 depends from claim 86.

Ferrel qualifies as prior art only under 35 U.S.C. § 102(e) because it issued after Applicant's effective filing date. Applicant does not admit that Munyan is prior art and reserves the right to swear behind Ferrel at a later date. Nonetheless, Applicant respectfully submits that the combination is improperly motivated and furthermore does not teach each and every element of the invention as claimed in claims 39-53, 55-131 and 137.

Ferrel discloses an on-line publishing system that separates the content for a multimedia document from the design of the document so that the content can be presenting in various layouts to different users. The content and layouts for a document are stored in a caching object store (COS) on a server. The content and layouts may also be stored on a COS on a user's computer if the document was previously accessed by the user. The user selects the document through a viewer, which retrieves the corresponding content and the particular layout from either the server COS or the local COS.

The Examiner asserts the motivation for combining Ferrel and Munyan is that the security coding of Munyan would discourage piracy of Ferrel's content. Because there is no need to apply Munyan's security coding to the server COS, the Examiner appears to be stating that Munyan's security coding would be applied to the user side COS. Applicant respectfully submits that the motivation is not supported by either reference or the art as a whole. As well-known in the art, data in an application cache on a user computer typically is transient and, moreover, cannot be directly accessed by the user. Ferrel neither teaches nor suggests that the user side COS can be copied by the user to a different computer. Therefore, nothing in the prior art suggests the desirability of coding the user side COS with a security identification code for the user computer. Accordingly, Applicant respectfully submits the combination is improper.

Furthermore, the combination of Ferrel and Munyan cannot be properly interpreted as disclosing all the elements of Applicant's invention as claimed in claims 39-53, 55-131 and 137.

With regard to independent claims 39 and 53, Applicant claims a library server that maintains a correlation between digital information files and information indicative of a player ID. The library server is separate from the mobile device that renders the content. The Examiner is relying on Munyan as disclosing this element. It is unclear if the Examiner is equating Applicant's claimed library server with Munyan's electronic bookstore server or with Munyan's electronic book. If the former, there is no teaching or suggestion in Munyan that the electronic bookstore server maintains a correlation as claimed. If the latter, Munyan discloses only that the electronic book device codes a removable stored device with the security identification code for the electronic book. There is no teaching or suggestion in Munyan that the electronic book device maintains a correlation between the security identification code and the downloaded content files themselves.

With regard to independent claim 72, Applicant claims that the library server creates a targeted header using information indicative of a player ID. The Examiner is relying on Munyan as disclosing this element. However, as set forth above with regard to the § 102 rejection, Munyan cannot be properly interpreted as disclosing Applicant's targeted header as claimed.

With regard to independent claim 56, Applicant claims that digital information files are targeted using information indicative of a player ID. The Examiner is relying on Munyan as teaching the targeting of digital information files. However, Applicant respectfully submits that Munyan does not disclose targeting individual content files, only the security coding of a removable storage device that holds the content files.

In claim 86, Applicant separately claims a computer system that targets programming content to a particular mobile device, and a mobile device that includes a player for rendering targeted programming content downloaded from the computer system. The Examiner is relying on Munyan as teaching the targeted programming content. Since the electronic book device, not the removable storage device, renders the content, the Examiner must be equating the claimed computer system with Munyan's electronic bookstore server and the claimed mobile device with Munyan's electronic book. However, Munyan does not teach or suggest that the electronic bookstore server targets the content to a particular electronic book.

Similarly, independent claim 110 separately claims a library server that targets access to digital information files to a particular mobile device, and a mobile device that includes a player for rendering digital information files downloaded from the library server. However, as set forth above, Munyan does not teach or suggest that the electronic bookstore server targets the access to content to a particular electronic book.

Claim 137 depends from claim 132. The Examiner has admitted that Ferrel does not teach Applicant's claimed targeted headers. Because Munyan also does not teach the claimed targeted headers as set forth above with regard to the rejection of claim 132 under § 102, the combination of Munyan and Ferrel cannot be properly interpreted as teaching each and every limitation of claim 137.

Therefore, the combination of Ferrel and Munyan cannot render obvious Applicant's invention as claimed in claims 39-53, 55-131 and 137, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination.

Claim 54

Claim 54 stands rejected under 35 U.S.C. § 103(a) as being obvious over Munyan and Ferrel. Applicant notes that the Examiner is also relying on Fernandez, U.S. Patent No. 4,5885,725, in rejecting claim 54. Applicant respectfully submits that the combination is improperly motivated and furthermore does not teach each and every element of the invention as claimed in claim 54.

Fernandez discloses a electronic book system in which a personal computer transfers files from a source, such as a read-only CD ROM drive, to a portable player connected to the computer. The user selects a file displayed on the computer and opens the cover of the portable player to send a transmission request from the portable player to the computer. The portable player sends its unique player identifier as part of the transmission request to the computer. The computer uses the player identifier to transmit the requested file to the correct player.

As set forth above, the combination of Ferrel and Munyan is improperly motivated. Therefore the further combination of Ferrel, Munyan and Fernandez also is improper.

Moreover, the further combination does not teach or suggest all the limitations of claim 54. Claim 54 separately claims a library server that encrypts a digital information file using information indicative of a player ID, and a CDROM generating device. The Examiner is relying on Munyan as disclosing the encrypting of content by a library server and Fernandez as disclosing the CDROM generating device. However, Fernandez specifically states the CD ROM drive is read-only and therefore it cannot be considered equivalent to Applicant's CDROM generating device. Moreover, Munyan does not teach or suggest that individual content files are encrypted by the electronic book device, but rather discloses that the removable storage device is coded with the security identification code without giving details of the coding used. Applicant respectfully submits that within the art encryption is considered subset of (en)coding but that the terms encoding and coding are also used for other data transformation methodologies. Furthermore, Munyan does not disclose that the electronic bookstore server encrypts a content file. Fernandez also does not teach or suggest using the player identifier to encrypt the files, but instead uses the player identifier to transmit a file to the proper player. Therefore, the

combination of Ferrel, Munyan and Fernandez does not disclose each and every limitation of claim 54.

Accordingly, the combination of Ferrel, Munyan and Fernandez cannot render obvious Applicant's invention as claimed in claim 54, and Applicant respectfully requests the withdrawal of the rejection of the claim under 35 U.S.C. § 103(a) over the combination.

SUMMARY

Claims 39-144 are currently pending. In view of the foregoing remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-8300 x309.

Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

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